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IN THE

Supreme Court of the United States

OCTOBER TERM, 1941

No. 865

W. D. HADEN COMPANY,
Petitioner,

v.

THE MATHIESON ALKALI WORKS, INC.,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE FIFTH CIRCUIT.

ROBERT S. BLAIR
DANIEL L. MORRIS
PAUL A. BLAIR
JOHN C. BLAIR
of Counsel.

January 12, 1942

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PETITION FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE FIFTH CIRCUIT.

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your Petitioner, W. D. Haden Company, respectfully prays for a writ of certiorari to the Court of Appeals for the Fifth Circuit to review the judgment of that Court entered on September 13, 1941 (R. Vol. IV, p. 2655). A Petition for Rehearing was duly presented and was denied on October 13, 1941 (R. Vol. IV, p. 2662).

SUMMARY AND SHORT STATEMENT OF THE MATTER INVOLVED.

This is a suit for infringement of a patent on a process for converting oyster shells into a high grade lime suitable for a variety of purposes, particularly in the chemical industry. The Petitioner was plaintiff below.

Petitioner, W. D. Haden Company, owned The Haden Lime Company in Houston, Texas, which operated a plant particularly designed for processing and burning oyster shells to make lime. The shells were dredged from large oyster shell reefs existing along the Gulf Coast. This was the first plant ever built and operated to convert such oyster shells into high grade lime, the operation following in detail the process of the patentee, Cecil R. Haden, of the patent in suit.

Respondent, The Mathieson Alkali Works, Inc., is a large chemical company engaged in the manufacture of a number of "heavy" chemicals, for example, caustic soda. It operates three large plants located at Saltville, Virginia, Niagara Falls, New York, and Lake Charles, Louisiana. The manufacturing processes of the Respondent require large quantities of high grade lime. Hence, Respondent at its Lake Charles plant utilizes without license the process of the patent in suit to convert oyster shells into such high grade lime for use in its other manufacturing processes. Respondent's Lake Charles plant was built with the close cooperation of Petitioner who granted Respondent the entire facilities of its plant and organization to help Respondent's engineers design and build the infringing plant, with the understanding, of course, that there would be adequate compensation for this cooperation. After completing the plant with Petitioner's help, Respondent refused to pay more than a nominal consideration for a license and nothing at all for Petitioner's cooperation (R. Vol. I, p. 358). Consequently, this suit was commenced.

Trial was had throughout February, 1939, before His Honor Judge Ben C. Dawkins in the District Court for the Western District of Louisiana and in an opinion dated November 30, 1939, that Court held all of the claims of the patent valid but so limited in scope that they were not infringed by the Respondent (Opinion, R. Vol. I, p. 64; 30 Fed. Sup. 617).

Petitioner appealed to the Circuit Court of Appeals for the Fifth Circuit and that Court affirmed the judg-

ment of the District Court in an opinion dated September 13, 1941 (Opinion, R. Vol. IV, p. 2652; 122 Fed. 2d 650).

Thereafter, on October 3, 1941, Petitioner filed a Petition for Rehearing (R. Vol. IV, p. 2657) before the said Court of Appeals. This petition was denied by the Court on October 13, 1941 (R. Vol. IV, p. 2662).

SUBJECT MATTER AND DECISIONS BELOW.

The patent here involved, No. 1,896,403 (R. Vol. III, p. 2028) is entitled "Process of Making Lime From Oyster Shells". An understanding of the subject matter of this patent and hence the issues of this controversy necessitates a brief review of the lime making operation.

The common source of lime is limestone which, in its original state and nature, is calcium carbonate. The term "lime" is sometimes loosely used to designate crushed limestone and sometimes crushed oyster shell, *i. e.,* fine calcium carbonate, which is sometimes used on farms for fertilizer. However, most "lime" results from the burning of this limestone which drives off the carbon dioxide in the calcium carbonate to produce calcium oxide. This simple chemical reaction can best be understood from a consideration of the chemical equation:

$CaCO_3$ (calcium carbonate) + Heat = CaO (calcium oxide or lime) + CO_2

The product resulting from this chemical reaction varies widely. If waste chips of limestone or the shucks of an oyster cannery are burned in a crude kiln with the fuel, the resulting mixture may be called "lime" although it is a mass of impurities and really good only for farmers in the sweetening of soil. On the other hand, if care is taken in the burning of lime to avoid impurities and other difficulties such as "overburning" and "underburning", the resulting high grade lime is of great value in a number of industries.

In certain coastal waters of this country, almost entirely along the Gulf Coast, there are large and extensive reefs of

oyster shell. These reefs cover an enormous area to a depth of 25 feet or more; hence they are available for dredging in quantities figured in millions of tons. This huge supply of oyster shell has long been known to exist and, in fact, such shells have been dredged for a great many years to be used, for example, in road building, as poultry feed, and for other like purposes requiring an inexpensive raw material. Oyster shells, except for impurities entrapped thereon, are pure calcium carbonate, the same as limestone.

In spite of the fact that these reefs were an obvious source of calcium carbonate for burning into lime, no one prior to Haden succeeded in transforming this carbonate into a high grade lime. In spite of a very large demand for a high grade lime, limestone remained the sole raw material even though it must be quarried or mined before burning. Also the lime resulting from this laborious limestone process must be shipped over long distances to localities where limestone is not available.

This was the situation when the patentee first investigated the possibility of converting these reef shells to a high grade lime. Although he interviewed a number of authorities and spent a great deal of time in his investigation, he met discouragement on every hand (R. Vol. III, p. 1852). The feeling of these experts was that any effort to make real lime from reef shell on a commercial scale was doomed to failure. Notwithstanding this discouraging advice, Mr. Haden proceeded with experiments and evolved the invention covered by the patent in suit.

Having satisfied himself that, in spite of the experts, this process was a real possibility, the patentee induced the Petitioner to spend many thousands of dollars in the building of a plant at Houston, Texas, for the processing and conversion of reef oyster shell to a high grade lime. This plant started operation in November, 1929, and has been in continuous commercial operation ever since. The appearance of this plant in the lime industry was somewhat of a sensation for not only had the "impossible" been proved to be commercially feasible but also the immediate

possibilities for the utilization of this vast supply of raw material were apparent. That the lime industry accepted the Haden process as a definite advance in the art is evidenced by the substantial interest in the building and operation of Petitioner's plant (R. Vol. IV, pp. 2105-17).

These oyster shell reefs along the Gulf Coast have probably been in the making for thousands of years and comprise almost entirely dead shells although there may be some live oysters on the surface thereof. The dead shells are a solid, compact mass of interconnected shell (R. Vol. III, p. 1830), *i. e.*, large "clusters" of shell bonded together at various surface points. Packed in with this conglomerate mass of shell is dirt, sand and silt, the whole comprising a sturdy mass of material necessitating that the reef be broken up with heavy apparatus in order to effect dredging.

The technical details of the Haden process will not be taken up in detail here. They involve many scientific problems having to do with the intricate difficulties of converting this dirty mass of interconnected shell into a high grade lime suitable for chemical use. However, a broad description of the fundamental steps of the Haden process is important to gain an intelligent comprehension of the very important error in law made by the Court of Appeals in its decision that the Respondent does not infringe the Haden patent in suit. Petitioner respectfully submits that this error (flatly *contra* to the settled rule of this Court) is so important and, if followed, will have such a serious effect on the patent system, as well as the public in its efforts to determine the scope of patents, that it warrants this Court in exercising its supervisory authority by granting this Petition to settle the law on this fundamental principle.

The Haden process comprises the utilization of certain equipment to carry out the various steps contemplated. This equipment may vary according to conditions. However, this process may be conveniently carried out as follows: a hydraulic dredge which has a long beam structure

on its bow (R. Vol. III, p. 2033) supports a large rotary "cutter head" (R. Vol. III, p. 2034) with cutting blades on its rotating surface. In operation the cutter head rotates to bite into the reef structure, breaks up the reef and the shells themselves into individual pieces which are sucked up onto the dredge by hydraulic mechanism and into a rotary screen (R. Vol. III, pp. 2067, 2070) where the shells are washed and small bits of shell eliminated along with the dirt (R. Vol. I, p. 595). The shells are then transported to a shore plant where they are usually rewashed in an additional rotary screen (R. Vol. III, p. 2041) eliminating further small particles of shell and dirt so that the resultant mass of shell is clean and free from small material. Throughout the operation the shells are subjected to such rough treatment that all laminations and pockets are opened to release dirt, later removed during the washing operations.

As described in the patent, the process may include the use of crushing mechanism at the shore plant for further reducing the size of the shell when it is too large for burning, after which it is screened resulting in shell of a "substantially uniform size". It is important to have shell of a "substantially uniform size" to avoid "overburning" and "underburning" with resultant failure to make high grade lime. Shell which is "substantially uniform size" for a long kiln, such as that used by Respondent, may not be of "uniform size" for a small kiln such as Petitioner's (R. Vol. III, p. 1508). Consequently, when using a small kiln, the dredging and washing operations may not effect sufficient crushing to get the shells down within a size range suitable for the kiln without a separate crushing apparatus.

In addition to the crushing needed to reduce the oversize shells to a "substantially uniform size", the shells, whether oversize or not, must also be sufficiently crushed or given such rough treatment on the surface that the usual rough laminations or pockets on the outside of the shell structure are broken open to release entrapped dirt, such as silt and sand, which collects in such shell structure over the years they remain on the reef. If the dirt entrapped

in these crevices were not removed, it would be sufficient to cause great trouble in the burning of the shells, *i. e.*, substantial dust formation in the kiln and "overburning" of the shells which conditions are responsible for an inferior lime. Therefore, it is highly important that the shells receive this rough treatment, which has sometimes been referred to as "surface crushing", to eliminate these entrapped impurities. In this way, shells which are otherwise chemically pure calcium carbonate differ markedly from limestone which is usually pure calcium carbonate but, being stone, does not contain entrapped impurities in or on the surface of its structure. In fact, this fundamental difference between oyster shells and limestone and the problems resulting therefrom, which were solved by Haden, is probably the reason why no one prior to Haden had been able to successfully burn shells into real lime. This is probably also the main reason why the experts were so discouraging in their advice to Haden before he commenced his experiments.

After the shells are crushed, washed and sized as described above, they are introduced into a cylindrical rotary kiln to produce lime.

Thus there are two types of crushing, one to remove impurities whether or not the shells be of proper size and the other to bring the shells down to a proper size for burning.

The claims in the patent are all process claims. They may be divided into three groups: Claims 1, 3, 4 and 5 which may be termed "crushing for size" claims; claims 6, 7, 8 and 9 which may be termed the "sizing" claims; and claim 2 which may be termed the "crushing for cleansing" claim. This is not to say that these are the only features in the claims but these are the dominant features of the respective claims. Claims 6, 7, 8 and 9 do not recite any crushing step, being broader and concerned with the sizing, washing and burning of the shells. Claims 1, 3, 4 and 5 recite the "crushing for size" step, the sizing step, the washing step and the burning step. Claim 2, unlike any other claim in the patent, recites the step of crushing

"to remove deposits of foreign material" and does not include the "crushing for size" step.

The District Court held that all of the claims (including claim 2) of the patent were limited to the "crushing for size" step and, more particularly, to the use of an apparatus such as a roll crusher for performing this step (R. Vol. I, p. 89). This in spite of the fact that (1) the claims are all process claims and hence not limited to the use of any particular apparatus:

> *Expanded Metal Company* v. *Bradford,* 214 U. S. 366; 29 Sup. Ct. 652;
>
> *Cochrane* v. *Deener,* 94 U. S. 780;
>
> *Waxham* v. *Smith, et al.,* 294 U. S. 20; 55 Sup. Ct. 277,

and (2) claims 2, 6, 7, 8 and 9 do not mention the "crushing for size" step. This error was particularly flagrant with respect to claim 2 of the patent which is specifically limited to the "crushing for cleansing" step and does not even mention the "crushing for size" step.

In appealing, Petitioner emphasized this error in interpretation of claim 2, but the Court of Appeals, in affirming the District Court, while admitting that claim 2 did not contain this limitation, nevertheless held that claim 2 should be qualified by the other claims and hence that this limitation should be read into the claim: "Claim 2 is the only one which does not mention sizing the shells. * * * Claim 2, which includes crushing of oyster shells must be read in connection with the other claims." (R. Vol. IV, pp. 2654-5.)

REASONS RELIED UPON FOR THE GRANTING OF A WRIT OF CERTIORARI.

The discretionary power of this Court is invoked, although this is an ordinary patent case and there is no conflicting decision with any other Circuit Courts of Appeal, for the following reasons:

1. The Circuit Court of Appeals for the Fifth Circuit, by a holding that Respondent avoided infringement of

claim 2 of the patent in suit because it did not employ the step of "crushing for size", (which step was not a part of Claim 2) ignored a well-settled rule of this Court that the limitations of one claim in a patent cannot be read into another claim to avoid infringement. That this rule has been finally established by this Court on numerous occasions cannot be questioned:

Altoona Publix Theatres v. *American Tri-Ergon Corporation,* 294 U. S. 477; 55 Sup. Ct. 455, 459;

Leeds & Catlin Company v. *Victor Talking Machine Company,* 213 U. S. 301; 29 Sup. Ct. 495;

Smith v. *Snow, et al.,* 294 U. S. 1; 55 Sup. Ct. 279;

T. H. Symington Co. v. *National Malleable Castings Co., et al.,* 250 U. S. 383; 39 Sup. Ct. 542.

Further, Petitioner urges that this is a most important principle of patent law which has been settled by and should be maintained by this Court. To disregard this ruling and allow the lower courts to proceed on any such theory would finally reduce the patent system to such a state of impotence that it could never achieve its accepted purpose of offering protection to inventors responsible for substantial advances in the arts. If the lower courts are to be permitted to disregard the rulings of this court by inserting limitations taken from other claims into claims where no such limitations exist, then it will be a practical impossibility to determine the scope of any patent. No one would be able to foresee what limitations a court might place upon any claim of any patent. Also because of the resulting vagaries in the patent system no one would be able to determine whether or not a certain product or process infringes a certain patent and hence whether or not he would be in a position to proceed without defending himself against serious and expensive charges of infringement.

2. There is no real possibility of any conflict of decisions between two Circuit Courts of Appeal in this con-

troversy, and consequently under the doctrine of *Paramount Publix Corporation* v. *American Tri-Ergon Corporation*, 293 U. S. 528, 548, 629; 55 Sup. Ct. 101, 139 and *The Schriber-Schroth Company* v. *The Cleveland Trust Company, et al.*, 304 U. S. 587; 58 Sup. Ct. 1052, your Petitioner prays that the Court will take jurisdiction of this controversy in the exercise of its discretionary power so to do. Practically all of these oyster shell-lime operations are situated in the Fifth Circuit, and practically all of the reef shell is off the Gulf Coast, the exceptions being of minor importance. Petitioner has a licensee under the patent in suit operating on the Pacific Coast. There are several sporadic operations in Virginia where oyster shell is burned for the purpose of making dirty fertilizer-lime and there is a plant in South Carolina manufacturing some lime from oyster shell cannery shucks. The Virginia operations have nothing to do with the process in suit; as a matter of fact, this type of fertilizer was made in the same way and in the same locality back in Revolutionary War days. While we have no first hand information of the operation in South Carolina beyond the fact that oyster shucks are used, the fact that the raw material is shucks indicates that such process is probably of no concern to Petitioner for the Haden process is primarily concerned with the conversion of reef shell to a high grade lime. These facts are all borne out by the letter from the Bureau of Mines submitted herewith. This bureau has definite knowledge of all of these lime operations and the letter substantiates the first hand information available to Petitioner.

In passing we note with interest that this bureau is evidently satisfied that Petitioner's plant at Houston, Texas, was the "pioneer in this industry".

On the other hand, large quantities of this oyster shell lime are being made daily in the Fifth Circuit, but your Petitioner cannot, in practicality, proceed against these infringers in view of the decision of the Circuit Court of Appeals for that circuit. Accordingly, Petitioner after spending many thousands of dollars to obtain his patent

and to enforce that patent against Respondent is now unable, purely because of the location of other infringing operations, to proceed any further even though he is convinced that other Circuit Courts of Appeal might well take a contrary view, thereby creating a conflict of decisions which would bring the matter before this Court. If the patent system is to be maintained, and it still enjoys statutory approval, it is certainly in the public interest to see to it that an inventor such as Haden be given the advantage of a hearing before this Court, especially where his plight is purely the result of an error of the only Court of Appeals available to him, which error is *contra* to the settled law as enunciated in numerous decisions of this Court.

PUBLIC IMPORTANCE.

Unlike the usual patent case, the error of the Circuit Court of Appeals for the Fifth Circuit, which may not only be followed in future decisions of that Court but which may be adopted by other courts in other circuits, will eventually result in reducing the patent system to such a vague and unsettled state of uncertainty that it will be quite impossible for the public to determine with any semblance of accuracy the scope of patents. Consequently, no one will be able to determine whether any article he proposes to put on the market or any process he proposes to practice infringes any patent because of a lack of any sound method of determining the scope of such patent prior to costly litigation.

The majority of patents issued by the United States Patent Office contain more than one claim and these claims have been allowed by trained examiners after extensive examination of the particular art to which the patent is directed. The various claims in a patent are usually first directed to the broader aspects of the invention and secondly to the more specific details. Often in determining matters of infringement some of the claims in a patent will be found to be infringed by particular structure or a particular process while others will be found to contain limitations which avoid infringement. This is the reason why

most patents contain more than one claim. It would be a practical impossibility for the patentee to maintain the protection to which he is entitled without more than one claim.

If, however, all of the claims in the patent are to contain all of the limitations of every claim in the patent, as held by the Circuit Court of Appeals for the Fifth Circuit, there no longer remains any reason for more than one claim in a patent. The patentee's protection would thus be limited most unfairly, and also there would be the resultant risk that the claim, if sufficiently broad, did not define his invention over the prior art which would invalidate the patent even though it dealt with an invaluable invention.

A logical conclusion of this theory of the Circuit Court of Appeals would be the lack of any necessity for any claims in the patent except some such general statement as "The invention as herein described in the specification and drawings". If the patent system is reduced to such a state of affairs, individual patent rights will become so ill-defined and susceptible to such manifold interpretation that the public will be continually harassed by unfounded or far-fetched charges of infringement. Furthermore, one charged with infringement will find it impossible to obtain any reliable information concerning his rights without resort to costly litigation.

WHEREFORE, your Petitioner respectfully prays that a writ of certiorari be issued to the United States Circuit Court of Appeals for the Fifth Circuit so that this cause may be reviewed and determined by this Court.

ROBERT S. BLAIR,
DANIEL L. MORRIS,
PAUL A. BLAIR,
JOHN C. BLAIR,
Of Counsel.

January 12, 1942.

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1941

No. _____

W. D. HADEN COMPANY,

Petitioner,

v.

THE MATHIESON ALKALI WORKS, INC.,

Respondent.

BRIEF FOR PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

THE OPINION OF THE COURTS BELOW.

The opinion of the District Court is reported in *W. D. Haden Company* v. *The Mathieson Alkali Works, Inc.* (R. Vol. I, p. 64, 30 Fed. Supp. 617). The opinion of the Circuit Court of Appeals for the Fifth Circuit is reported in *W. D. Haden Company* v. *The Mathieson Alkali Works, Inc.* (R. Vol. IV, p. 2652, 122 Fed. 2d 650).

JURISDICTION.

The judgment of the Circuit Court of Appeals for the Fifth Circuit is dated September 13, 1940 (R. Vol. IV, p. 2655). The statute under which jurisdiction is invoked is Section 240 (a) of the Judicial Code (28 U. S. C. 347, as

amended). Among the cases in this Court which are l
lieved to sustain the jurisdiction are:

Paramount Publix Corporation v. *American T*
Ergon Corporation, 293 U. S. 528, 548, 629;
Sup. Ct. 101, 139;

The Schriber-Schroth Company v. *The Clevela*
Trust Company et al., 304 U. S. 587; 58 Su
Ct. 1052; and

Carbice Corporation of America v. *American Pa*
ent Development Corporation, 293 U. S. 27;
Sup. Ct. 334.

STATEMENT OF THE CASE.

The facts so far as this application is concerned a
sufficiently stated in the petition.

SPECIFICATION OF ERRORS.

The errors which Petitioner will urge if the writ
certiorari is granted are that the Circuit Court of Appea
for the Fifth Circuit erred:

1. In affirming the decree of the District Court holdi
the Respondent does not infringe patent No. 1,896,403.

2. In reading a limitation contained in some of t
claims in the patent into claim 2 of the patent where
such limitation appears.

ARGUMENT.

Your Petitioner will not burden this Court with a d
tailed analysis of the merits of this controversy. In fa
your Petitioner will not attempt to elaborate complete
on the details of the proper factual background whi
should be used in an interpretation of the claims of t
patent in suit.

1.—The Court of Appeals disregarded a fundamental principle of patent law established by this Court when it read the "crushing for size" limitation into claim 2 of the patent and held that the claim was not infringed because of this limitation.

There is a vast difference in purpose in the two crushing steps of the Haden process. The "crushing for size" step which appears, for example, in claim 1 has the purpose of reducing the shell to a "substantially uniform size" to prevent "underburning" and "overburning". The "crushing for cleansing" limitation appearing in claim 2 (which claim does not have the "crushing for size" limitation) is to open up shell laminations, pockets, and crevices which contain such impurities as silt and sand so that these may be removed from the shell and hence further insure against impurity in the resulting lime product. Both of these steps are important features of the Haden process but under all conditions it is not essential to practice both of them in order to practice the Haden invention.

As admitted by Respondent's chief engineer during trial, the longer the kiln in which the shells are burned, the greater the range may be between the minimum size of shells and the maximum size of shells (R. Vol. III, p. 1668). Thus, it is conceivable that given a certain type of reef shell which comprised shell particles between a certain maximum and a certain minimum, it might be possible to design a kiln long enough to take the maximum size of shell in this raw material and thus eliminate the necessity of "crushing for size". Under these circumstances it would not be necessary for one practicing the Haden invention to use this step.

It might also be conceivable, although improbable, to find a body of this reef shell having a very wide range between its smaller and larger particles but, because of some fluke of nature, having a rather smooth surface with few laminations, if any, and consequently little, if any, entrapped dirt. Under these assumed improbable circum-

stances it might not be necessary to practice the "crushin for cleansing" part of the Haden process although th larger particles might have to be broken down, henc necessitating the "crushing for size".

It is for this reason that the Haden patent, like al patents, contains claims (claim 1) limited to the "crush ing for size" step without any mention of the "crushin for cleansing" step. The patent also contains claim which does not mention "crushing for size" but define in particularity the "crushing for cleansing" limitation

Haden discovered the advantages of practicing both o these crushing steps according to the particular raw mate rial being used, and therefore the Patent Office recognized the justice of granting him specific protection for both steps separately in combination with the burning opera tions necessary to convert the processed shell to lime. I is only for this reason that claims of the type of claims and 2 appear in the Haden patent. Obviously, if the Pat ent Office had not believed that both of these steps in com bination with the other steps of the process were patent able, no such claims as these would have appeared in the Haden patent. Possibly, there would have been no Haden patent; possibly, the Patent Office would have insisted upon a claim defining the combination of both steps of crushing.

The Circuit Court of Appeals admitted that claim 2 did not contain this "crushing for size" limitation: "Claim 2 is the only one which does not mention sizing the shells." (R. Vol. IV, p. 2654.) But, said the Court, "Claim 2, which includes crushing of oyster shells must be read in connection with the other claims." (R. Vol. IV, p. 2655.) It continued by holding that there was no "crushing for size" in the Respondent's process, and, consequently, claim 2 as well as the other claims in the case could not be infringed.

That it was necessary to read this "crushing for size" limitation into claim 2, in order to hold the claim uninfringed, is emphasized by the holding of the District Court that defendant does practice the "crushing for cleansing" step as recited in the claim. The District Court held that defendant's apparatus and various operations, before burn-

ing the shell, crushes and breaks up the shell. It held that this crushing and breaking serves to open up the laminations and crevices on the surfaces of the shell to remove dirt deposits that are entrapped therein. The District Court in speaking of this crushing stated (Finding 20, R. Vol. I, p. 89): "It is also true that this procedure likewise serves to open some of the surface laminæ and to remove therefrom such impurities as can be reached by washing in the screens."

Certainly we have here the lifting of an entire step from one claim and placing it in another claim where it does not exist purely to limit the latter claim in such manner that it will not be infringed. This is directly *contra* to the well-established rule of this Court that each claim must stand on its own feet, that the interpretation of each claim is independent and cannot be confused with the problems incident to a consideration of the other claims, that the validity of a claim cannot be sustained by reading into it the limitations of another claim and that the infringement of a claim must be determined in the light of the terminology of that claim without help or hindrance from other claims in the Patent.

Your Petitioner submits that this is an important principle of law necessitating a definite ruling by this Court for the protection of the public. To continue the principle enunciated by the Circuit Court of Appeals for the Fifth Circuit would be a very serious blow to the patent system, and, more important, an additional burden on the public in its effort to determine the scope of patent protection.

2.—Due to the peculiar circumstances existing in this industry there is no possibility of any conflict of decisions between the Circuit Court of Appeals for the Fifth Circuit and any other Court of Appeals.

As previously explained the Haden process is particularly designed for the conversion of reef oyster shells into a high grade chemical lime. Although such reefs exist in San Francisco Bay, they are comparatively insignificant in

extent, and there is only one company using this process in that locality; that company has recognized the value of the Haden invention for it is a licensee under the Haden patent. The other deposits of these shells are located along the Gulf Coast which is entirely within the Fifth Circuit. It is a tribute to the Haden invention that since the building and operation of the Haden plant, which made the Haden process well known, a number of chemical companies have constructed large plants along the Gulf Coast for the practice of various chemical processes needing large quantities of high grade lime. For example, the Respondent built its plant at Lake Charles at a cost of over eight million dollars (R. Vol. III, p. 1796) after making a very careful analysis of the Haden process and availing itself of all of the engineering experience of your Petitioner. Because of the ruling of the Circuit Court of Appeals for the Fifth Circuit in this case Haden is prevented in practicality from proceeding against any of these other companies who are now availing themselves of the fruits of the Haden invention without giving any compensation therefor.

Accordingly, for the reasons set forth hereinabove, it is respectfully submitted that this case justifies this Court in exercising its discretionary power to grant a writ of certiorari to the Circuit Court of Appeals for the Fifth Circuit to review the judgment in this case by that Court.

Respectfully submitted,

ROBERT S. BLAIR
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January 12, 1942

APPENDIX.

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1941

No. --------

W. D. HADEN COMPANY,

Petitioner,

v.

THE MATHIESON ALKALI WORKS, INC.,

Respondent.

UNITED STATES
DEPARTMENT OF THE INTERIOR
BUREAU OF MINES
WASHINGTON

January 9, 1942

MR. JOHN C. BLAIR,
BLAIR, CURTIS AND HAYWARD,
60 East 42d St.,
New York, N. Y.

Dear Mr. Blair:

In reply to your telephone inquiry regarding lime made from oyster shells, several companies use shells as raw material for lime manufacture. There are 4 or 5 small operators in Virginia and Louisiana that use shells for mak-

ing limited quantities of agricultural lime for local use. The larger producers are located near the Gulf of Mexico and the Pacific Coast. One company operating near Oakland, Calif., makes lime from shells on a large scale in connection with its output of sea-water products.

Most of the large producers of lime from shells are in coastal area bordering the Gulf of Mexico. The Haden Lime Company, of Houston, Texas, was the pioneer in this industry. The company developed a process for making high-grade chemical lime by calcining oyster shells in a rotary kiln, and began operation of the first plant to employ this process in 1929. Subsequently several other companies began production of lime from shells in the Gulf Coast region.

I trust that the information given herein will be useful to you.

Very truly yours,

OLIVER BOWLES,
Assistant Chief,
Nonmetal Economics Division

CPY5925

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FILED
JAN 30 1942
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

No. 865

W. D. HADEN COMPANY,
Petitioner,

vs.

THE MATHIESON ALKALI WORKS, INC.,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

RAYMOND F. ADAMS
LESLIE B. YOUNG
CURT VON BOETTICHER
E. HOWARD M'CALEB
of Counsel

January 30, 1942

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Statement of the Case

Respondent has been engaged in the manufacture of alkalies from calcium carbonate and salt at Saltville, Virginia for many years (II. 1189-90, 1364-6). After an investigation begun in the late 1920s, it constructed a plant for conducting these operations at Lake Charles, Louisiana and some time later put the plant in operation (I. 551, II. 1385).

Calcium carbonate, available as limestone at Saltville, was available as dredge-washed oyster shells at Lake Charles. Such dredge-washed oyster shells, dredged and washed with conventional equipment, had been a commodity available in that vicinity prior to petitioner's first

work in making lime from shells (I. 206-9, II. 891, 1104, 1131-2). The use of a rotary kiln for calcining shell as well as limestone was not novel with petitioner (IV. 2433, 2483 bottom left column, 2486 under conclusions).

In respondent's practice at Lake Charles such dredge-washed shells are charged, by the use of conventional handling and conveying equipment, into rotary kilns (IV. 2350-2, II. 1104-1115, 1160, 1175-7, III. 1510, 1836, 1935, IV. 2358, 2377). No crusher of any kind is used. The shell material entering the kiln is not sized but ranges from whole shells to dust (IV. 2631-2, respondent's Exh. 27 reporting petitioner's analysis per II. 868-70, and see II. 879, 1065-7, III. 1521-5). In the kiln the shell material is calcined to produce lime and carbon dioxide both of which are used in respondent's own operations (II. 1364-6). The purity of the lime is substantially lower than that petitioner asserts to be characteristic of its product. (Compare petitioner's Exh. T-12, IV. 2172, corrected per I. 567-70, with petitioner's Exh. T-11, IV. 2177).

During respondent's investigation, respondent was referred to petitioner by an associate to which petitioner was then supplying dredge-washed shell (III. 1803). Petitioner, which had previously published the details of its operations (I. 323-7, II. 895-7, IV. 2103, 2185, 2632-8), tried to get from respondent a contract for its shell requirements and to satisfy respondent that the shells it would supply were suitable for conversion into carbon dioxide and lime (I. 175-6, 326-9). During negotiations petitioner's patent appeared and petitioner advised respondent that petitioner expected the patent to protect the petitioner's shell business and to secure for petitioner a limited monopoly in the unpatented material, dredge-washed shell (IV. 2288-90, petitioner's Exh. X-131).

The patent in suit (III. 2028-32) describes and claims a process characterized as an "exact procedure" comprising crushing, washing and sizing of shell supplied to a rotary kiln. After stating that a majority of the silt and

sand can be removed by using a rotary screen with the mechanical dredging equipment usually employed (page 1, lines 85-99), the patent specification states that nevertheless small deposits of sand and silt remain "included in the shell structure" and then states that, in the process of the patent, this shell material is crushed, to expose dirt trapped within the shell structure for removal by subsequent washing, and to limit the maximum size of the pieces of shell (page 1, line 99-page 2, line 26).

There is no reference in the specification to any crushing in the conventional dredge or dredge screen, or in conventional handling equipment, or to petitioner's term "surface crushing". Distinction between kinds of crushing, one of which cleans without sizing and another which sizes without cleaning, urged by petitioner, is without support in the specification. The only crushing described in the specification is done in a crusher which both liberates dirt included in the shell structure and limits the maximum size of the pieces of shell.

The application for patent, as filed, included other claims broader than those of the patent (IV. 2401, claims originally numbered 1, 2, 3 and 4). These other claims were not limited to a process including the step of crushing or the step of sizing. These other claims were rejected on art and cancelled under rejection in order to secure the patent (IV. 2405, 2415, 2425 and 2426).

Respondent, exercising its right to be free with respect to dredge-washed shell, an unpatented and unpatentable commodity, made arrangements to obtain its shell from others (III. 1795, 1798, IV. 2222-4). This suit was thereupon instituted.

The District Court construed the claims of the patent by reference to other claims rejected and cancelled during prosecution of the application and found the patent so construed to be valid but not infringed (Opinion I. 65-82). The Court of Appeals affirmed the District Court (Opinion IV. 2652-5).

Argument

Petitioner's argument proceeds upon an incorrect representation of the basis on which the courts below determined the scope of the claims of the patent, and particularly claim 2. Petitioner correctly quotes the Court of Appeals as saying that "Claim 2, which includes crushing of oyster shells must be read in connection with the other claims." (Brief p. 16). The Court of Appeals said this after saying that the District Court had held that " 'crushing' as used in claim 2 was qualified by the other claims to mean sizing" (IV. 2654). The "other claims" to which both courts referred were the rejected claims cancelled during prosecution of the application on which the patent issued. The first twelve pages of the District Court's opinion are devoted to an identification of the subject matter of these other claims and an analysis of the effect of their rejection and cancellation upon the scope of the remaining claims under the doctrine of *I. T. S. Rubber Co.* v. *Essex Rubber Co.*, 272 U. S. 429, 443 (I. 65-77). Neither court applied the rule petitioner suggests to have been the basis for the asserted error upon which petitioner relies. Both courts applied a very different rule and a correct rule. The rule applied by both courts was reaffirmed by this Court, after the District Court's opinion and before affirmance by the Court of Appeals in *Schriber-Schroth Co.* v. *Cleveland Trust Co., et al.*, 311 U. S. 211, 220.

Petitioner presents a false issue, apparently seeking to have the real issue of infringement redetermined without reference to those restrictions in scope the Court of Appeals and the District Court found necessary to sustain the validity of the patent.

This is an ordinary patent case with the usual issues of invention, breadth of claims and non-infringement. The usual rules have been applied in the usual way in determining these issues. The determination of the issues

rests on concurrent findings of validity of the patent and non-infringement by respondent by the courts below. There is no conflict of decision and no proper or adequate showing of improbability of conflict (*post* p. 6). The adjudication of validity does not impair petitioner's right to enforce the patent against infringement of the process of the patent.

We therefore submit that the petition should be denied.

RAYMOND F. ADAMS
LESLIE B. YOUNG
CURT VON BOETTICHER
E. HOWARD M'CALEB
of Counsel

January 30, 1942

APPENDIX

UNITED STATES
DEPARTMENT OF THE INTERIOR
BUREAU OF MINES
Washington

January 27, 1942.

Mr. Raymond F. Adams,
Pennie, Davis, Marvin and Edmonds,
247 Park Avenue,
New York, N. Y.

Dear Mr. Adams:

In reply to your letter of January 21 relating to lime manufactured from oyster shells, the letter written to Mr. John C. Blair on January 9, to which you refer, was in answer to certain specific inquiries as to locations in the United States where lime is made from oyster shells and the early history of its production in the Gulf Coast region.

The reply to these questions was based on records in our files. The letter answered only the questions asked and, therefore, is not to be regarded as a complete presentation of all data available on oyster-shell lime, nor was it intended as an exhibit in a court document.

Very truly yours,

(signed) OLIVER BOWLES
OLIVER BOWLES,
Assistant Chief,
Nonmetal Economics Division.

PENNIE, DAVIS, MARVIN AND EDMONDS
COUNSELLORS AT LAW
247 Park Avenue
New York

January 21, 1942

Mr. Oliver Bowles
Bureau of Mines
Washington, D. C.

My dear Mr. Bowles:

I am enclosing a copy of a petition for a writ of certiorari which has been filed in the United States Supreme Court in W. D. Haden Company vs. The Mathieson Alkali Works, Inc. I represent The Mathieson Alkali Works.

You will find on pages 19 and 20 of this petition a reproduction of a letter addressed to Mr. John C. Blair over your signature under date of January 9, 1942. Mr. Blair represents the W. D. Haden Company.

This letter is being used to represent to the Supreme Court a state of facts with respect to the production of lime from oyster shells which, if my information is correct, is incomplete and, being incomplete, is misleading.

In order to prevent misuse of your letter of January 9, 1942 in the circumstances, which I am sure you did not intend, I would like to have from you a statement of the circumstances under which the letter was written and the extent to which you intended this letter to be a complete survey of the pertinent facts.

I intend to use such a statement from you to refute, if necessary, any improper inferences which might be drawn from your earlier letter to Mr. Blair.

Very truly yours,

(signed) RAYMOND F. ADAMS

Enclosure